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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,916	10/30/2003	Clayton Smith	2180-001	5649

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EXAMINER
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FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/695,916

Applicant(s)

SMITH ET AL.

Examiner

Michael J. Feely

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 11-56 is/are allowed.
- 6) ☒ Claim(s) 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Pending Claims***

Claims 1-56 are pending.

### ***Claim Objections***

1. The objection to claims 43 & 44, 46 & 47, 49 & 50, 52 & 53, and 55 & 56 has been overcome by amendment.
2. The objection to claims 45-47 has been overcome by amendment.

### ***Claim Rejections - 35 USC § 102***

3. The rejection of claims 1-13, 17, 27-32, 45-47, and 54-56 under 35 U.S.C. 102(b) as being anticipated by Foley (US Pat. No. 3,728,277) has been overcome by amendment.

### ***Claim Rejections - 35 USC § 103***

4. The rejection of claims 20-22, 37, and 51-53 under 35 U.S.C. 103(a) as being unpatentable over Foley (US Pat. No. 3,728,277) in view of Poelker et al. (US Pat. No. 6,100,221) has been overcome by amendment.
5. The rejection of claims 14-16, 18, 19, 23-25, 33-36, and 38-40 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Foley (US Pat. No. 3,728,277) and Poelker et al. (US Pat. No. 6,100,221) in view of McDougall et al. (US Pat. No. 4,738,897) has been overcome by amendment.

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6. The rejection of claims 26 and 41 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Foley (US Pat. No. 3,728,277) and Poelker et al. (US Pat. No. 6,100,221) in view of Blezard et al. (US Pat. No. 5,807,810) has been overcome by amendment.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites a range of *from 0% to about 50%* for the corrosion inhibitor. The corrosion inhibitor is required in the parent claim; therefore, it is unclear how it can have a range of 0%.

Claim 6 recites the limitation "the scale inhibitor" in the fluid of claim 1. There is insufficient antecedent basis for this limitation in the claim. This claim should be dependent from claim 2.

Claim 7 recites the limitation "the salt inhibitor" in the fluid of claim 1. There is insufficient antecedent basis for this limitation in the claim. This claim should be dependent from claim 2.

Claim 8 recites the limitation "the oxygen scavenger" in the fluid of claim 1. There is insufficient antecedent basis for this limitation in the claim. This claim should be dependent from claim 2.

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Claim 9 recites the limitation "the biocide" in the fluid of claim 1. There is insufficient antecedent basis for this limitation in the claim. This claim should be dependent from claim 2.

Claim 10 recites the limitation "the non-emulsifier" in the fluid of claim 1. There is insufficient antecedent basis for this limitation in the claim. This claim should be dependent from claim 2.

***Allowable Subject Matter***

9. Claims 1-4 and 11-56 are allowed.

10. Claims 5-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

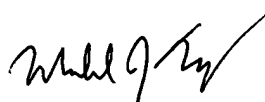
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***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely  
Primary Examiner  
Art Unit 1712

December 11, 2006

**MICHAEL FEELY  
PRIMARY EXAMINER**